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09/874,856	06/05/2001	Alic Anthony Scott	8579	5088

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EXAMINER

YU, GINA C

ART UNIT	PAPER NUMBER
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1617

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14

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 14

Application Number: 09/874,856
Filing Date: June 05, 2001
Appellant(s): SCOTT ET AL.

MAILED
DEC 03 2003
GROUP 2900

KENYA T. PIERRE
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed August 4, 2003.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

Appellant's brief includes a statement that claims 1-4 and 6-25 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

5,614,200	BARTHOLOMEY	3-1997
5,389,363	SNYDER	2-1995

(10) Grounds of Rejection

The following ground(s) of rejection as also indicated in the Office action dated December 27, 2002 are applicable to the appealed claims:

Claims 1-4 and 6-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bartholomey et al. (US 5614200) ("Bartholomey") in view of Snyder et al. (US 5389363) ("Snyder").

Bartholomey teaches mascara compositions comprising lecithin (Phospholipon 80), which meets the limitations of instant claim 1(a) and 2-4; and ammonia acrylate copolymer (Syntran 5170) which meets the limitations of instant claims 1(c) and 6-8. See Examples; see also the disclosure of fractionated lecithin in col. 5, lines 31-48. Adding film-forming agents such as PVP and PVP/VA copolymers is suggested in col. 5, line 49 – 6. See instant claim 1(b). The example formulas in Bartholomey also teaches to use waxes, glyceryl monostearate, water/ethanol solvents, black iron oxide, triglyceride, and preservatives. See instant claims 9 and 12-25. The weight ratio of glycerol monostearate to lecithin as required by instant claims 10-11 are disclosed in col. 5, lines 11 – 30.

Bartholomey fails teach the specific type of PVP copolymers in instant claim 1(b).

Art Unit: 1617

Snyder teaches a waterproof mascara formulations comprising 1.5 % of PVP/tricontanyl copolymer. See Examples 1 and 2. See also col. 4, line 55 – col. 5, line 8.

Given the general teaching of using film-forming agents such as PVP copolymers in mascara formulation in Bartholomey, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have looked to the prior art such as Snyder for specific types of the film-forming copolymers conventionally used in the art. Alternatively, the skilled artisan would have been motivated to modify the Bartholomey invention by adding PVP tricontanyl copolymer as suggested by Snyder because of the expectation of successfully producing waterproof mascara.

(11) *Response to Argument*

1. Examiner takes the position that the collective teachings of the cited references meet every limitation of the presently claimed composition.

Using PVP/tricontanyl polymer and lecithin in the claimed weight range to formulate a mascara composition is well known in the art, as evidenced by Bartholomey and Snyder. Bartholomey teaches in Formulation 2, a mascara composition comprising 2.50 % by weight of lecithin and 0.25 % by weight of PVP/VA copolymer. Snyder teaches that PVP/tricontanyl polymer is an oil-soluble film-forming polymer conventionally used in a mascara composition, and discloses a formulation, which employs the polymer in the amount of 1.50 % by weight of the total composition. See Snyder, Example 2. While applicants recite “from about 0.1 to

Art Unit: 1617

about 30 %, by weight of the composition, of at least one resin", examiner asserts that resin is present in the film-forming polymer itself.

2. It would have been prima facie obvious to combine the teachings of the Bartholomey and Snyder references, and applicants failed to rebut the proposed obviousness rejection.

In examiner's view applicants' assertion that the rejection cites no motivation or suggest to combine the references is erroneous because, as the rejection states above, the motivation to combine the references is based on the objective teaching in Snyder that the PVP tricontanyl polymer is a well-known oil-soluble film-forming polymer in mascara composition art. Applicants are silent as to why such teaching fails to provide a skilled artisan motivation to use the PVP polymer to formulate a similar, anhydrous mascara formulation. While applicants assert that the present invention is effective in "detangling and separating lashes", which are not described in the prior arts, applicants' argument is not commensurate with the scope of the claims. Nor applicants provide objective evidentiary support to assert any unexpected or surprising results of the otherwise obvious combination of the prior arts.

Applicants' assertion that the present composition eliminates the need for "setting rate agent" used in Bartholomey, examiner finds the argument unpersuasive because the prior art setting rate agent composes of the very same components which are also present in the instant invention. Bartholomey teaches that the setting rate agent is a mixture of glycerol monostearate and lecithin. See Bartholomey, col.


Art Unit: 1617

4, lines 43-44. Applicants require both components in instant claim 1 and claim 9.


See also specification pages 23-27.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,


Gina Yu
Patent Examiner
November 28, 2003

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12/1/03